

REMARKS

Claims 1-3, 5-16, and 18-24 are pending in this application. Claims 1-3, 5, 9-16, and 20-24 stand rejected under 35 U.S.C. 102(e). Claims 6-8, 18, and 19 stand rejected under 35 U.S.C. 103(a).

The following remarks put the pending claims in condition for allowance. Applicants respectfully request reconsideration and the timely allowance of the pending claims. A favorable action is awaited.

35 USC § 102(e) Rejection

Claim 16 stands rejected under 35 U.S.C. 102(e) for allegedly being anticipated by Muhanna et al. (published US application 2002/0058860).

The Examiner contends Muhanna et al. teach each and every element of the invention of claim 16 of the instant application. Specifically, the Examiner contends that the manual tightening of the cable that is essential to the method of claim 16 is not recited in the claim. Applicants respectfully disagree with the Examiner's characterization.

Muhanna et al. teach a surgical instrument holder having an electrically operable tensioning device (see paragraph 0035). Claim 16 of the instant application is directed to a method of stabilizing a localized area of tissue on a patient, comprising the steps of providing a segmented arm support apparatus including an articulating arm with a plurality of segments, each segment having a passage for receiving a cable and tightening the cable so that the plating material of the segments frictionally engages, causing the device to lock. One of ordinary skill in the art would recognize from the language of claim 16, read in light of the specification, that the device for tightening the cable is manual. In the interest of furthering prosecution, claim 16 has been amended to more clearly define this feature of the invention. Accordingly, the Applicants respectfully request that the rejection of claims 16 under 35 U.S.C. § 102(e) be withdrawn.

Claims 1-3, 5, 9-16, and 20-24 stand rejected under 35 U.S.C. 102(e) for allegedly being anticipated by Gannoe et al. (published US application 2002/0077532).

The Examiner contends that Gannoe et al. teach each and every element of the invention of claim 16 of the instant application. Specifically, the Examiner contends that

articulating arm taught by Gannoe et al. comprises a plurality of segments that are the same size and shape and that this anticipates the instant claims. Applicants respectfully disagree with the Examiner's characterization.

Upon reading the specification of the instant application, one of ordinary skill in the art would recognize that claims 1-3, 5, 9-16, and 20-24 are directed to a segmented arm support apparatus including an articulating arm with a plurality of segments, each segment having the same size and shape. In the interest of furthering prosecution, claims 1 and 16 have been amended to more clearly define this feature of the invention. Accordingly, the Applicants respectfully request that the rejection of claims 1-3, 5, 9-16, and 20-24 under 35 U.S.C. § 102(e) be withdrawn.

35 U.S.C. § 103(a) Rejection

Claims 6-8, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gannoe et al. (published US application 2002/0077532) in view of Leyden et al. (U.S. Patent No. 6,371,345). This rejection is respectfully traversed. Applicants respectfully put forth that the combined teachings of Gannoe et al and Leyden et al. do not contain each and every element of the claimed invention. Further, one of ordinary skill in the art would not be motivated to combine these references in order to make the claimed invention.

The Examiner contends that Gannoe et al. teach each element of the claimed invention but does not specify if the plating material is necessarily softer than the material forming the segments. The Examiner further contends that this deficiency is cured by Leyden et al. Applicants respectfully disagree.

Claims 6-8, 18, and 19 of the instant application are directed to, *inter alia*, a segmented arm support apparatus including an articulating arm with a plurality of segments having the same size and shape and each segment being formed of a material with high stiffness and coated with a high friction plating material and wherein the high friction plating material is softer than the material with high stiffness. As stated above, Gannoe et al. do not teach each and every element of the claimed invention. In particular, Gannoe et al. do not teach a segmented arm support apparatus including an articulating arm with a plurality of segments, each segment having the same size and

shape. This deficiency is not cured by Leyden et al. Leyden et al. is directed to an adjustable mounting device for use with electronic devices such as personal data assistants, GPS devices, and CD players. Leyden et al. do not teach an articulating arm with a plurality of segments, each segment having the same size and shape. Thus, the combination of Gannoe et al. and Leyden et al. does not teach or suggest the invention of claims 6-8, 18, and 19.

It is respectfully submitted that the cited references do not provide sufficient teaching or disclosure to support the combination relied on by the Examiner for the obviousness rejection. There is no disclosure or suggestion in the references of the claimed combination to support the combination created by the Examiner. Further, it is respectfully submitted that the Examiner has improperly used hindsight to recreate the claimed invention.

To render a claimed invention obvious based on a combination of references, the references must suggest the desirability of the combination asserted to teach or suggest the claimed invention MPEP 2143.01 citing *In re Mills* 916 F.2d 680, 16 USPQ2d 1430 (Fed.Cir. 1990). It is not enough that the references may be capable of combination. Even if a given combination of references teach the individual elements of a claimed invention, which in this case they do not, it has repeatedly held that to support an obviousness rejection, the references must suggest the desirability of modification of the cited documents to produce the claimed invention. For instance, in *In re Laskowski*, the Federal Circuit held that the “mere fact that the prior art could so be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989) Furthermore, “[i]t is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion or incentive to make the combination made by the inventor.” *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed.Cir. 1990), cert denied, 498 US 920. Accordingly, the standard for the proper combination of references to form a rejection under 103 requires a teaching of the desirability of combining the references be found in the cited art.

The Examiner's contention that it would be obvious to ordinary skill in the art to combine the teachings of Gannoe et al. and Leyden et al. is misplaced, as there is no motivation to combine the teachings of these two references. While Leyden et al. may discuss a coating to be used on the ball member to increase frictional resistance it does not teach or suggest the use of frictional coatings on surgical devices. Leyden et al. does not even address frictional coatings in a general fashion, its teachings are limited to mounting devices for use with electronic devices such as personal data assistants, GPS devices, and CD players. As such, there is no motivation to combine Gannoe et al. and Leyden et al.

Given that the combined teachings of Gannoe et al. and Leyden et al. do not contain each and every element of the claimed invention and that there is no motivation to combine these references the Applicants respectfully request that the rejection of claims 6-8, 18, and 19 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

As all of the outstanding rejections have been addressed and all of the claims are believed to be in condition for allowance, the Applicants respectfully request a Notice of Allowability. The Examiner is invited to contact the undersigned representative should any further issues arise.

Respectfully submitted,

DECHERT LLP

Date: Feb. 24, 2004

John W. Ryan

John W. Ryan
Reg. No. 33,771

Thomas M. Haas
Reg. No. 50,210

Dechert LLP
1775 I Street, N.W.
Washington, D.C. 20006
Telephone (202) 261-3375
Fax (202) 261-3333